

Attorney Docket No. 1199 P 196

PATENT
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

2005 NOV -8 PM 10:22

US PATENT & TRADEMARK
OFFICE

In re Application of:
Andrew L. Oleson

Application No.: 10/814,373
Confirmation No.: 5499
Filed On: March 31, 2004

Examiner: Marissa L. Ferguson

Art Unit: 2854

For: INDIVIDUAL HEAD OFF-CONTACT SHIMS

Mail Stop 16
Finance Office, Refund Section
Director of the U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REFUND OF APPEAL FEE

Dear Sir:

Applicant hereby requests a refund of the \$500 fee paid with its Notice of Appeal of August 15, 2005, under 37 C.F.R. § 1.26 because the Examiners took back the application to re-review their prior work and re-issue an Office Action before Applicant could pursue an Appeal. In short, the Examiners recognizing their prior error(s), usurped the Appeal before Applicant could pursue it. For these reasons, explained more fully below, a refund is justified and appropriate.

On August 3, 2005, the Examiners issued an Office Action, made final, for the above case. Upon review, counsel noted the Examiners had not even read counsel's prior response.

As a result, on August 15, 2005, Applicant filed a Reply to Final Office Action Mailed August 3, 2005, explaining to the Examiners their gross error and unsatisfactory handling of the application and the need for an Appeal. Applicant simultaneously filed a Notice of Appeal to the Board of Patent Appeals and Interferences and paid the required \$500 fee. Applicant's Reply specifically stated:

Attached is a Notice of Appeal filed for the present case and filed simultaneously with the present Response. Upon review of the Examiner's most recent Office Action, Applicant is of the firm belief the Examiner failed to read, let alone consider, Applicant's prior Response to the March 31, 2005 Office Action. The

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Examiner's cursory handling of the present application without due consideration makes the present Appeal necessary.

Specifically, the Examiner ignored Applicant's revised claims and arguments, cited inapplicable law and parroted the prior Office Action without thought. It is clearly evident by a cursory review of the Action, made Final, that little attention or care went into the review of Applicant's prior Reply. For example, the Examiner continues to misread and misapply Holderegger; the Examiner cites *St. Regis Paper Co. v. Bemis Co.*, 193 U.S.P.Q. 8 (7th Cir. 1977) for a proposition that is not set forth in the case, a case which appears to have several propositions no longer recognized by the Court of Appeals for the Federal Circuit; the Examiner also cites *In re Leshin*, 125 U.S.P.Q. 416, (CCPA 1960) and extrapolates and applies it incorrectly to the alleged proposition; the Examiner states in paragraph 3 that Claims 3, 7, 16, 20, 31 and 35 are allowable when they are not even pending; and, the Examiner's only Response to Applicant's arguments is the boilerplate statement (in paragraph 6) that such arguments "have been considered but are moot in view of the new ground(s) of rejection" when there are, in fact, no real new grounds for rejection.

Accordingly, Applicant believes it is necessary to bring the above actions and inactions to the attention of the Board wherein they may be addressed and due consideration to Applicant's application may be had.

On September 14, 2005, counsel discussed the situation with the Examiners. The Examiners apologized for the handling of the application and acknowledged the rejections maintained in the Final Office Action were improper. The Examiners also advised they would issue a new office action thereby making an Appeal – at this time - unnecessary. (See Exhibit A).

The Examiners unilaterally usurped the Appeal before Applicant could proceed with it. No brief had been presented. Therefore, Applicant believes a refund in the amount of \$500 is in order.

Applicant hereby requests a refund of the \$500 Notice of Appeal fee to be credited to Deposit Account No. 23-0280.

Respectfully submitted,

Date: November 2, 2005

By: 

Roger H. Stein, Reg. No. 31,882
Wallenstein Wagner & Rockey, Ltd.
311 South Wacker Drive, 53rd Floor
Chicago, Illinois 60606-6630
312.554.3300

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Attorney Docket No. 1199 P 196
Application No. 10/814,373
Page 3

CERTIFICATE UNDER (37 C.F.R. § 1.8a)

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop 16, Finance Office, Refund Section, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450 on November 2, 2005.

Natalie L. Kurowski

Natalie L. Kurowski/234507.1

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OCT 20 2005

WALLENSTEIN WAGNER & ROCKEY, LTD.

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TO DOCKETING

To: Mr. Roger Stein

From: Marissa Ferguson

Fax: 312-554-3301

Date: October 20, 2005

Phone: 312-554-3300

Pages: 2 (including cover sheet)

☐ Urgent ☒ For Review ☐ Please Comment ☐ Please Reply ☐ Please Recycle

•Comments: Enclosed is a copy of the Informal Interview summary. It will become formal when the action has been counted, scanned and mailed.

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| | | | |
|--------------------------|---------------------|------------------|--|
| Interview Summary | Application No. | Applicant(s) | |
| | 10/814,373 | OLESON, ANDREW L | |
| | Examiner | Art Unit | |
| | Marissa L. Ferguson | 2854 | |

All participants (applicant, applicant's representative, PTO personnel):

(1) Marissa L. Ferguson.

(3) Roger Stein.

(2) Andrew Hirshfeld.

(4) _____

Date of Interview: 20 October 2005.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal (copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.
If Yes, brief description: _____

Claim(s) discussed: _____

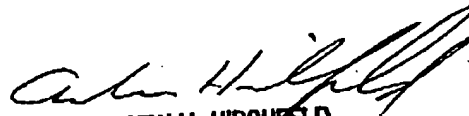
Identification of prior art discussed: _____

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Attorney Stein was informed by the examiner that a new office action will be mailed.

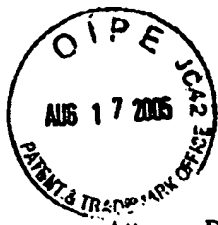
(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.


ANDREW H. HIRSHFELD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required



RESPONSE UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2854

AF
2854
ICW

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For: Individual Head Off-Contact Shims

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Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**NOTICE OF APPEAL FROM THE EXAMINER TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Dear Sir:

Applicant hereby appeals to the Board from the decision of the Examiner Marissa Ferguson mailed August 3, 2005, finally rejecting Claims 59-80.

The fee for this Notice of Appeal under 37 C.F.R. § 1.17(b) is \$500 and check, No. 24952 in this amount is enclosed. Applicant is other than a small entity.

This Notice is timely submitted.

The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. 23-0280. A duplicate copy of this Transmittal is attached.

Respectfully submitted,

Date: 15 August 2005

By: _____

Roger H. Stein, Reg. No. 31,882
Customer Number 23424
Wallenstein Wagner & Rockey, Ltd.
311 S. Wacker Drive, 53rd Floor
Chicago, Illinois 60606-6630
312.554.3300

08/18/2005 SHASSEN1 00000034 10814373

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500.00 DP

CERTIFICATE OF MAILING (37 C.F.R. § 1.8a)

I hereby certify that this correspondence is, on the date shown below, being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on Aug. 15, 2005.

Kathleen Rundquist
Kathleen Rundquist/230339

Adjustment date: 12/13/2005 SDIRETA1
08/18/2005 SHASSEN1 00000034 10814373
01 FC:1401 -500.00 DP

Repl'n. Ref: 12/13/2005 SDIRETA1 0008115400
DAH: 230280 Name/Number: 10814373 \$500.00 CR
FC: 9204